AF/ZLW

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

BOARD OF PATENT APPEALS AND INTERFERENCES

Application No.: 10/014,977	**Confirmation No. 3321**
Applicant: Michael Webber	
Filed: December 10, 2001	
TC/AU: 3736	
Examiner: R. Nasser	
Docket No. 147117-100002	
Customer No. 34026	

Mail Stop Appeal Brief - Patent
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

REPLY BRIEF

The Examiner's Answer agrees that (1) the statement of the status of claims as set out in Appellant's Brief is correct; (2) the summary of the claimed subject matter as set out in Appellant's Brief is correct; (3) the statement of the grounds of rejection to be reviewed on appeal as set out in Appellant's Brief is correct; (4) the copy of the appealed claims contained in

CERTIFICATE OF MAILING
(37 C.F.R. §1.8a)

I hereby certify that this paper (along with any referred to as being attached or enclosed) is being deposited with the United States Postal Service on the date shown below with sufficient postage as First Class Mail in an envelope addressed to the Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

Fay Lum-Lee
Name of Person Mailing Paper

November 10, 2005
Date of Deposit

Fay Lum-Lee
Signature of Person Mailing Paper

the Appendix to Appellant's Brief is correct; and (5) the statement in Appellant's Brief that the Kiefer reference (relied on by the Examiner as one of the references in all of the Examiner's obviousness rejections of the claims on appeal) "would need to be modified to accommodate the changes" required by the combination of cited references is correct. This appeal deals only with the single issue of the appropriateness of combining the references cited by the Examiner.

The Appellant's invention measures two components of breath. The first component is continuously monitored by measuring light absorption to determine the presence of alveolar breath. The second breath component is optically measured when alveolar breath is present in the immediately previous expired breath thereby triggering the measurement of the second breath component. The Kiefer reference teaches analyzing alveolar breath, but not optically. The Forrester reference teaches optics, but neither Kiefer or Forrester teach measuring the second breath component based on an immediately previous breath. The Phillipps reference is cited in an effort to supply this claim limitation. Kiefer and Forrester are in the chemistry art classification (art units 23 and 436 respectively). Phillipps is in the surgery art unit (128). Phillipps does not measure any component of breath, much less two breath components. Rather, it determines changes in a patient's thoracic volume, and then filters a heart rate signal. (Col. 2, lines 45-51.)

Kiefer discloses a filament 17 in an electrical bridge circuit with a fixed threshold (Col. 4, lines 13-15). Forrester also discloses a fixed, predetermined threshold (Col. 1, line 51). Yet the Examiner's position is that Phillipps can be combined with Kiefer and Forrester "to update the thresholds based on previous measurement(s)" (Examiner's Answer, p. 6), though to do so would require removal of fixed filament 17 and replacement with another filament of different

threshold--all in the time between two patient breaths--something that is of doubtful possibility, and nowhere described in any cited prior art.

Here is the support for the Examiner's position (at page 6 of the Examiner's Answer) that he did not engage in impermissible hindsight in combining Phillipps with Kiefer and Forrester:

> Appellant asserts that Phillips does not measure two components of breath or any component of breath and therefore there is no suggestion to combine Phillips with the references. The examiner disagrees. The only feature not shown by the Kiefer and Forrester combination is to update the threshold based on the previous measurement. It is well known in the medical field to update the thresholds based on the previous measurement(s) so as to tune the measurement circuit to measurement to the anomalies of each individual patient. (Emphasis added.)

But see MPEP § 2143.01:

> IV. FACT THAT THE CLAIMED INVENTION IS WITHIN THE CAPABILITIES OF ONE OF ORDINARY SKILL IN THE ART IS NOT SUFFICIENT BY ITSELF TO ESTABLISH *PRIMA FACIE* OBVIOUSNESS
>
> A statement that modifications of the prior art to meet the claimed invention would have been "'well within the ordinary skill of the art at the time the claimed invention was made'" because the references relied upon teach that all aspects of the claimed invention were individually known in the art is not sufficient to establish a *prima facie* case of obviousness without some objective reason to combine the teachings of the references. (MPEP emphasis.)

And see *Al-Site Corp. v. VSI International, Inc.*, 50 U.S.P.Q.2d 1161, 1171 (Fed. Cir. 1999).

> ("To imbue on of ordinary skill in the art with knowledge of the invention in suit, when no prior art reference or references of record convey or suggest that knowledge, is to fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher.") Skill in the art does not act as a bridge over gaps in substantive presentation of an obviousness case, but instead supplies the primary guarantee of objectivity in the process. (Emphasis added, citations omitted).

And here is the Examiner's position (at page 7 of the Examiner's Answer) that the fixed threshold of Kiefer and Forrester do not teach away from altering the threshold:

> Appellant further asserted that Kiefer would need to be modified to accommodate the changes. The examiner agrees, but notes that such changes are expected when proposing a modification under 35 USC 103 and are a matter of routine experimentation for one skilled in the art.

Not only does the Examiner once again improperly rely on the skill in the art to bridge over gaps in his obviousness contentions, but the modification of electrical circuitry of Kiefer or Forrester could scarcely be performed between patient breaths, that is to say the modification in an effort to meet applicant's claims would be inoperative. See *In re Gordon*,, 221 U.S.P.Q. 1125, 1127 (Fed. Cir. 1984):

> We are persuaded that the board erred in its conclusion of prima facie obviousness. The question is not whether a patentable distinction is created by viewing a prior art apparatus from one direction and a claimed apparatus from another, but, rather, whether it would have been obvious from a fair reading of the prior art reference as a whole to turn the prior art apparatus upside down. French teaches a liquid strainer which relies, at least in part, upon the assistance of gravity to separate undesired dirt and water from gasoline and other light oils. Therefore, it is not seen that French would have provided any motivation to one of ordinary skill in the art to employ the French apparatus in an upside down orientation. The mere fact that the prior art could be so modified would not have made the modification obvious unless the prior art suggested the desirability of the modification. [Citations omitted.]
>
> Indeed, if the French apparatus were turned upside down, it would be rendered inoperable for its intended purpose. (Emphasis added, citation omitted.)

In conclusion, it is respectfully submitted that the Examiner improperly relied on a hindsight reconstruction based on Phillipps of the Kiefer and Forrester principal references, not based on any suggestion in the references, but rather based on a contention of what would have been known to one of ordinary skill in the art. Moreover, the Phillipps reference that the

Examiner seeks to add to Kiefer and Forrester is from a non-analogous field, and there is nothing in the records to suggest that the modification could be accomplished "based on the concentration of the first component in only the immediately previous expired breath" as claimed by Appellant.

It is urged that the claims be allowed in their present form.

Respectfully submitted

JONES DAY

Date: November 10, 2005

By _____
Coe A. Bloomberg
Reg. No. 26,605
Attorney for Applicant

555 South Flower Street, 50th Floor
Los Angeles, CA 90071-2300
(213) 489-3939